

REMARKS

This application has been carefully reviewed in light of the Official Action mailed September 14, 2007. Claim 1 is amended above. Claims 2-4 are canceled above without prejudice or disclaimer. Claim 1 remains pending in this case. Applicant respectfully requests reconsideration of this application and favorable action on all the remaining claims in this case in view of these amendments and the following remarks.

In the Official Action, the Examiner rejected claims 1-4 under 35 USC § 112 as being indefinite because the limitation “the operation” in line 10 of claim 1 lacked antecedent basis. Claim 1 has been amended above to correct this lack of antecedent basis.

In the Official Action, the Examiner rejected claims 1, 2, and 4 under 35 USC § 102(e) as being anticipated by U.S. Patent No. 6,336,904 to Nikolchev (“Nicholchev”). Amended claim 1 requires, in a system for illuminating the interior space within an eye:

a cannula having a distal end and a proximal end;
a hollow handle constructed and arranged for mounting said cannula;
said distal end of said cannula being constructed and arranged for
insertion into said interior space of said eye;
said proximal end of said cannula being constructed and arranged for
connection to said hollow handle;
said distal end of said cannula further including a light emitting diode;
***a receiver disposed within said hollow handle and electrically
connected to said light emitting diode via a wire passing through said hollow
handle and said cannula; and
a transmitter disposed external to said handle;
whereby a brightness of said light emitting diode is controlled via a
wireless interface between said transmitter and said receiver.***

(emphasis added). Such a system allows for wireless control of the brightness of the light emitting diode of the illumination system, which in turn provides greater flexibility to the surgeon. *See, e.g.*, page 5, line 20 through page 6, line 4 and page 4, lines 14-16 of the subject application.

Nikolchev does not disclose “a receiver disposed within said hollow handle and electrically connected to said light emitting diode” or “a transmitter disposed external to

said handle”, much less “whereby a brightness of said light emitting diode is controlled via a wireless interface between said transmitter and said receiver”, as required by claim 1. In contrast, Nicholchev is totally silent regarding such limitations. For at least these reasons, claim 1 is novel over Nicholchev.

The Examiner rejected claim 3 as being unpatentable over Nicholchev in view of U.S. Patent Application Publication No. 2001/0052930 to Adair et al (“Adair”). The Examiner acknowledged that Nicholchev does not disclose a wireless configuration, but stated that Figure 8 of Adair discloses a wireless endoscope device.

Claim 3 has been canceled above without prejudice or disclaimer. In addition, Nicholchev and Adair fail to teach “a receiver disposed within said hollow handle and electrically connected to said light emitting diode” and “whereby a brightness of said light emitting diode is controlled via a wireless interface between said transmitter and said receiver”, as required by claim 1. As acknowledged by the Examiner, Nicholchev is totally silent regarding a wireless configuration. Adair merely discloses that its transceiver radio element 170 disposed within handle 12 of its endoscope (a) receives a video signal from image sensor 40 via cable 32 and then wirelessly transmits the video signal to external transceiver radio module 178 for display on monitor 196 and (b) receives authentication signals and control signals for image sensor 40 from external transceiver radio module 178. *See* Adair, Figures 6-9 and paragraphs 79, 83. For at least these reasons, claim 1 is patentable over Nicholchev and Adair.

In summary, the differences between the subject matter of amended claim 1 and the prior art cited by the Examiner are significant. Given these differences, claim 1 would not have been obvious at the time the invention was made to a person of ordinary skill in the art. In addition, there is no suggestion in the prior art to modify the teachings of Nicholchev and Adair so as to reach the requirements of claim 1, much less its associated benefits as described above. Absent such suggestion, any such modification would necessarily be based on the improper hindsight application of Applicant’s own teachings. For these additional reasons, claim 1 is patentable over Nicholchev and Adair.

Applicant has made an earnest attempt to place this case in condition for full allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant

respectfully requests reconsideration of this application and full allowance of all claims remaining in this case.

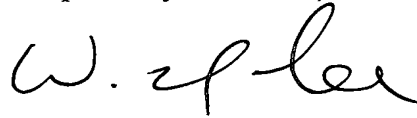
The Commissioner is hereby authorized to charge the following fee amounts required or credit any overpayment associated with the filing of this Amendment to **Deposit Account No. 501051 of Alcon, Inc.:**

- 1) The fee amount of \$1050.00 for the Petition for Extension of Time for three (3) months, from December 14, 2007 to March 14, 2008, to respond to the Official Action, which is being filed concurrently with this Amendment.

The Commissioner is hereby authorized to charge any other amount required for the filing of this Amendment, or credit any overpayment, to **Deposit Account No. 501051 of Alcon, Inc.**

Should the Examiner have any questions regarding this Amendment, please feel free to contact the undersigned attorney at the phone number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "W. David Lee". The signature is fluid and cursive, with the first letters of the first and last names being capitalized and prominent.

W. David Lee
Reg. No. 39,743

Alcon Research, Ltd.
IP Legal TB4-8
6201 South Freeway
Fort Worth, Texas 76134-2099
Tel: 817/568-6029
Fax: 817/551-4610